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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,815	06/02/2006	Dirk Gandolph	PD030124	1952
24498	7590	07/28/2008		
Joseph J. Laks			EXAMINER	
Thomson Licensing LLC			FRENEL, VANEL	
2 Independence Way, Patent Operations				
PO Box 5312			ART UNIT	
PRINCETON, NJ 08543			PAPER NUMBER	
			3687	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,815

Applicant(s)

GANDOLPH ET AL.

Examiner

VANEL FRENEL

Art Unit

3687

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/02/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- Paper No(s)/Mail Date 20060602
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 12 recites "being usable for modifying the visibility of at least one other menu item".

In claim 12, line 13 recites "means for modifying the visibility of at least one other menu item to said button command". There are insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-6, 9, 11-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-6, 9, 11-12 recite a process comprising the steps of generating, connecting, coding. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9

(1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon et al. (2002/0013944).

(A) As per claim 1, Gordon discloses a method for generating an interactive electronic menu on a display, the menu comprising menu items wherein a menu item may be in a deselected, selected or activated state, and the menu being coded into a menu data segment-comprising: a connecting at least a first and a second menu item by a parent-child relationship, wherein the second menu item being a child of the first menu item can only be selected when the first menu item is selected (See Gordon,Figs.5-6; Page 5, Paragraphs 0047-0049); and coding the first and the second menu item into

the same menu data segment, wherein at least one button command is associated with a menu item and coded into said menu data segment, the button command being usable for modifying the visibility of at least one other menu item (See Gordon, Figs.5-6: Page 4, Paragraphs 0036-0038).

(B) As per claim 2, Gordon discloses method wherein the second menu item is only visible when the first menu item is in the selected state (See Gordon, Page 4, Paragraphs 0037-0039).

(C) As per claim 3, Gordon discloses method wherein the second menu item is not selectable (See Gordon, Page 5, Paragraph 0046).

(D) As per claim 4, Gordon discloses method according claim 1, wherein the menu data segment contains at least for the first and the second menu item neighbour information, the neighbour information defining which other menu item may be selected when said first or second menu item is in the selected state (See Gordon, Page 5, Paragraphs 0043-0045).

(E) As per claim 5, Gordon discloses method wherein the menu relates to the content of a read-only storage medium, and the menu data segment is stored on the respective read-only storage medium (See Gordon, Fig.4; Page 2, Paragraphs 0026-0027).

(F) As per claim 6, Gordon discloses method wherein said other menu data item and is also coded into said menu data wherein the visibility also comprises the colour look-up table relating to a menu item (See Gordon, Page 3, Paragraphs 0032-0038).

(G) As per claim 9, Gordon discloses method wherein a third menu item is connected to the second menu item by a parent-child relationship, wherein the third menu item being a child of the second menu item can only be selected when the second menu item is selected, and wherein the first, the second, and the third menu item are coded into the same data segment (See Gordon, Page 5, Paragraphs 0047-0049).

(H) As per claim 11, Gordon discloses method wherein the parent-child relationship within the menu data segment is indicated by a unidirectional or bi-directional link or identifier (See Gordon, Page 4, Paragraph 0041).

(I) As per claim 12, Gordon discloses apparatus for generating an interactive electronic menu on a display, the menu comprising menu items, wherein a menu item may be in a deselected, selected or activated state, and the menu being coded into a menu data segment, wherein it comprises means for selecting menu items, wherein at least a first and a second menu item are connected by a parent-child relationship, wherein the second menu item being a child of the first menu item can only be selected when the first menu item is selected (See Gordon, Page 5, Paragraphs 0043-0048);

means for decoding a data segment containing code of the first and the second menu item, wherein at least one button command is associated to a menu item and coded into said menu data segment (See Gordon, Page Figs.5-6; Page 4, Paragraphs 0036-0038), and means for modifying the visibility of at least one other menu item according to said button command (See Gordon, Figs.5-6; Page 4, Paragraphs 0036-0038).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches interface method for providing information about items on a list for interactive television (5,897623),

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3687

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vanel Frenel/
Examiner, Art Unit 3687
July 21, 2008